

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 12, 14, 24, 32-34, 37-40 and 45 are pending after entry of the above amendment.

Claims 2, 3, 7-9, 12, 14, 17-24 and 31-44 were examined. Claims 2, 3, 7, 12, 14, 23, 32-34, 37-40 and 44 were rejected. Claims 17-22 and 41-43 were allowed. Claims 8, 9, 31, 35 and 36 were objected to.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

In the Official Action of May 30, 2003, the Examiner rejected claims 12, 14, 24 and 37 under 35 U.S.C. Section 112, second paragraph, as being indefinite. The Examiner rejected claims 12 and 14 for depending upon canceled claim 11, and rejected claims 24 and 37 as being duplicates of one another. In response thereto, Applicants have amended claim 12 so as to depend from claim 24, and have amended claim 37 so as to differentiate from claim 24.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 12, 14, 24 and 37 under 35 U.S.C. Section 112, second paragraph, as being indefinite, as being no longer appropriate.

Claims 12, 14, 24 and 37 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., U.S. Patent No. 6,139,492. The Examiner asserted that Vierra et al. shows a device having first and second shafts 25 (the proximal end of element 17) which are joined by an articulating link 41 and/or 51. The Examiner further asserted that the shafts terminate in blocks 15 and 17 having ports 73 therein which can be connected to a source of suction for aspirating fluids away from the site of application.

Applicants respectfully submit that, as noted in the previous response, Vierra et al. provides holes 73 on the inside surfaces of arms 15 and 17, not on or in the bottom surfaces. The holes 73 are connected to a lumen 75 which may be coupled to a vacuum source to suction fluids from the surgical site out of the patient. Accordingly, Vierra et al. would not want to position the holes on the bottom

surfaces, since this would prevent the ability to suction fluids from the surgical site. Accordingly, Applicants respectfully submit that Vierra et al. clearly fails to anticipate the claims at issue.

To still further clarify this point, Applicants have amended claim 24 above to recite block-shaped housings, each having a bottom contact surface configured to engage the surface of the heart, and a plurality of suction ports having openings disposed in said bottom surface. Not only are the surfaces of Vierra et al., in which holes 73 are positioned, clearly not bottom surfaces, but they are also clearly not adapted to contact the surface of the heart, as contact with tissue would block the ability to suction fluids away from the site.

Claim 37 has been amended to recite, *inter alia*, suction members interconnected through an articulating link; each of said suction members comprising a contact surface adapted to contact the surface of the heart, each said suction member being configured to apply negative pressure to the surface of the heart so as to fix said contact surface against the surface of the heart. It is respectfully submitted that Vierra et al. clearly fails to disclose or suggest such features.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 12, 14, 24 and 37 under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., as being clearly appropriate.

Claim 44 was rejected under 35 U.S.C. Section 102(b) as being anticipated by Palmer et al., U.S. Patent No. 5,290,082. In view of the above cancellation of claim 44, without prejudice, it is respectfully submitted that this ground of rejection is now moot and should be withdrawn.

Claims 2, 3, 7 and 23 were rejected under 35 U.S.C. Section 103 as being unpatentable over Palmer et al., U.S. Patent No. 5,290,082, in view of Nishiguchi et al. In view of the above cancellation of claims 2, 3, 7 and 23, without prejudice, it is respectfully submitted that this ground of rejection is now moot and should be withdrawn.

Claims 33-35 were rejected under 35 U.S.C. Section 103(a) as being obvious over Vierra et al., U.S. Patent No. 6,139,492, in view of Slater, U.S. Patent No. 5,417,709 and Borst et al., U.S. Patent No. 5,927,284. The Examiner asserted that Vierra et al. shows all of the features of claims 33-35, except that the feet are not interlinked by a pivot, but rather by two pivots and that the feet frictionally engage the heart surface, rather than engage the heart surface by using suction. The Examiner applied Slater as teaching that it would have been obvious to modify the device of Vierra et al. to use only one pivot, instead of two. Applicants do not agree that it would have been obvious to modify the device of Vierra et al. to replace the current mechanism with a scissors joint. Such would require the replacement of the

concentric shafts 43 and 3 with a pair of scissoring shafts, which would be detrimental to the functioning of the device in less invasive environments such as the one shown in Fig. 5.

The Examiner further stated that it would have been obvious to modify the device of Vierra et al. to use suction as the engaging force, substituted for the mechanical engaging force of Vierra et al. Again Applicants respectfully disagree. Even if the feet of Vierra et al. were modified to apply a suction engaging force, the feet would still need to apply a mechanical force to perform the function required of the Vierra et al. device. That is, the Vierra et al. device is used to cross clamp the coronary artery on both sides of an anastomosis target while the heart is stopped, see Fig. 5. This requires pressure. Therefore there would be no motivation to modify the Vierra et al. device as suggested, as replacing the mechanical forces with suction would not effectively close off the coronary artery.

Applicants note that claims 33 and 34 depend from claim 32, and that claim 32 has not been rejected. This is perhaps due to a typographical error. Regardless, Applicants submit that claims 32-34 are allowable over the applied art for at least the above reasons. As to claim 35, it is noted that this claim has been canceled above, without prejudice.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 33-34 (claim 35 having been canceled, without prejudice) under 35 U.S.C. Section 103 as being obvious over Vierra et al., U.S. Patent No. 6,139,492, in view of Slater, U.S. Patent No. 5,417,709 and Borst et al., U.S. Patent No. 5,927,284, as being inappropriate.

Claims 38-40 were rejected under 35 U.S.C. Section 103(a) as being obvious over Vierra et al., U.S. Patent No. 6,139,492, in view of Borst et al., U.S. Patent No. 5,927,284. Applicants assume that the Examiner used the same reasoning for combining these references as in the above rejection of claims 33-35 over Vierra et al., Slater et al., and Borst et al. For the same reasons set forth above, Applicants respectfully submit that it would not have been obvious to combine Vierra et al. and Borst et al. in the manner suggested by the Examiner.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 38-40 under 35 U.S.C. Section 103 as being obvious over Vierra et al., U.S. Patent No. 6,139,492, in view of Borst et al., U.S. Patent No. 5,927,284, as being inappropriate.

Applicants wish to extend their appreciation to the Examiner for the allowance of claims 17-22 and 41-43, and the indication of allowable subject matter in claims 8, 9, 31, 35 and 36.


Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-003DIV2.

Respectfully submitted,
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